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EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 09/08/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

# Office Action Summary

Application No.

09/512,085

Applicant(s)

COATES, FREDRICA V.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 June 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: FLYER.

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## **DETAILED ACTION**

### ***Specification***

### ***Drawings***

1. The corrected or substitute drawings were received on 6-20-03. These drawings are not approved.

While the 6-2-03 drawings appear to overcome some of the drawing objections (It is noted that Applicant has not provided a specific explanation of the changes made and/or marked up copy, see attached flyer, so it difficult for the Examiner to determine exactly what changes have been made. Also the drawings were not properly labeled as replacement drawings, see attached flyer), the drawings do not overcome all of the objections, e.g. the cross sectional lines still include letters, the line from 110 in Figure 8 is still not dashed, and due to the amendments to the specification and/or the proposed Figures new objections are present, e.g. 61B is not shown in Figure 2 as now described and 62 does not show elastic in Figure 2A as now described. See also attached PTO-948.

2. The drawings are objected to because the Figures are still replete with informalities. For example: All the cross sectional lines, e.g., 1A-1A, etc. need to be denoted by only Roman or Arabic numerals. The line from 10 should either be an arrow or the line should extend all the way to the structure it denotes in Figures 2, 3,4. This applies to 50 in Figure 3A, 11 in Figures 5 and 6, 100 in Figure 7, 13 in Figure 7B and 14 in Figure 9 also. The line from 24

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should be dashed to denote underlying structure in Figures 2-4. This applies to 110, 12A and 42 in Figures 7-9 also. In Figure 3E, 80 should be 86. In Figure 4, 62A, 62C, 66A, 66C, 67A, 67C, and 67B, and 67C are not properly shown, e.g. 66A is shown as being inside the pocket, 62A should be 64A, 62C should be 64C and 62B should be 67B, and 67C does not denote the tacking of 67A. In Figures 7A, numeral 50 should not be underlined and a line therefrom should extend to the structure it denotes. In Figure 8, where is 22? See discussion of the objection to the specification *infra* also. It should be noted that these examples are merely illustrative. Applicant should carefully review and revise, as necessary, all the Figures. Correction is required.

### ***Description***

3. The disclosure is objected to because of the following informalities: The specification is replete with informalities. For example:

1) On page 4, line 16, where is line 3B-3B set forth? 2) In Figures 2, 3, 4, what is 100? 3) In Figure 1H, what is 43? 4) In Figure 1F, what is 17A? Also, the first paragraph of the Summary on page 2 is still grammatically incorrect, i.e. words missing? 5) The description in the insert at page 7, lines 15-17, the inserts at page 8, lines 1-2, and second and third full paragraphs, and Figures 1D-1F with respect to the numerals 42, 21, 21A, 42A, 42B are inconsistent. For example, the numeral 42 is used to denote and describe four different

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structures which improper, i.e. it is used to describe the seam or stitch line and the edges of the removed corners and the edges of the seam and the smooth finished surface of elastic 40. For another example, the last sentence of the insert to page 8, third paragraph is unclear as to what is being described because there are two arrows in Figure 1D. Corners are still described and shown by both numerals 21 and 21A with respect to Figure 1D. Also note in Figure 1F 21 is used to describe the cutout area not the corner piece removed, see Figure 1D. For a third example what are 42A and 42B? For a fourth example, in the amendment to the third full paragraph on page 8, the stitch line 17 is described on lines 3-4 as overlaying itself. A clear consistent showing and description of the structure using consistent terminology and numerals should be set forth. 6) The description of Figures 2-2E on page 9, line 7-page 11, line 2 and Figures 2-2E are also still inconsistent. For example, what are 64 and 65? For another example, Figure 2A is not a cross section along line 2A-2A because cuff 60 is at the end not the side. In Figure 2A 68 denotes the space not the sling and 20 does not denote the stitching. Where is strip 62 in Figure 2A? In Figure 2, the edges 61B and 71 and seamline 71A, as best understood, are interior of the pocket but are not denoted as such. The numeral 71 is used to denote both the edge and the seamline, and the edge is denoted both 71 and 71A, and 61B is used to describe both the edge and denote the edge, and 61 is described as both the cuff and the seam. Applicant now appears to be defining Figure 2 as showing an intermediate step of construction prior to sealing in the paragraph bridging pages 9-10 which is inconsistent with the description of Figure 2 on page 4. Where in Figure 2 is the structure as set forth in the first full paragraph on page 10, last

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sentence thereof? In Figure 2C, 60 and 61 do not denote the cuffs which are described as being of folded material, i.e. there is no folded material. The stitching 70 in Figures 2C-2E and that in Figure 2 is shown differently, i.e. rectangle versus hourglass. A clear consistent showing and description of the structure using consistent terminology and numerals should be set forth. 7) The description in the amendment to page 11, line 3, line 5 thereof, i.e. alternative use of Velcro and snaps, and Figures 3 and 3A are still inconsistent. Again a clear consistent showing and description of the structure using consistent terminology and numerals should be set forth. 8) The remarks with regard to 6) supra also apply to the same structure shown and described with respect to Figures 4-4B. 9) The description at page 12, line 11-page 14, line 15 and Figures 5-6B are still inconsistent. For example, the numeral 162 and 163 are used to describe different structures in Figures 5-5B and 6-6B. Where are the sides bent and joined at a seam in Figure 5A as described? Strip 403a? In Figure 5, where is 409? In Figure 6, left side, strip 620 is shown inside and outside the pocket. Where are 163' and 163A in Figure 6 as now described? Element 108 is shown as a seam but is described as overlock stitching. Where in Figure 6A is the structure shown as set forth on page 14, lines 12-13. Pocket elastic is described as both 400A and 40 and shown as 400A. Where is 620A? A consistent clear showing and description of the structure using consistent terminology and numerals should be set forth. 10) The description on page 14, line 16-page 16, last line, Figures 7-9 and Figure 1 are inconsistent. For example, the numeral 42' is used to structure which structure is denoted differently in Figure 1 but described as the same in the second full paragraph on page 15 as now amended. For another example,

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where is 43 shown? What is 102? 11) It should be noted that these examples are merely illustrative. The entire specification should be carefully reviewed and revised, as necessary.

Appropriate correction is required.

#### ***Claim Objections***

4. Claims 1-3, 10 and 17-19 are objected to because of the following informalities:  
In claim 10, line 1, "A" should be --The--. In claim 1, second to last line, "user" should be --inner-- to be consistent. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. Claims 1-3, 10 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant now claims the four sides of the inner layer being displaced laterally inward from corresponding sides of the anchor layer. While such is accurate with regard to the side edges of the inner layer, the term "laterally" would not apply to the end edges of the inner layer with respect to the corresponding sides of the anchor layer. Sides displaced from the corresponding sides of the anchor layer in a direction towards a center of the anchor layer would be accurate with regard to all sides.

#### ***Claim Rejections - 35 USC § 102***

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6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brownlee et al. See Figures, especially Figures 7-8, col. 2, lines 25-34 and col. 4, lines 52-59, e.g. outer layer and anchor layers are plies of body 12, also note Figure 10, and col. 4, line 59- col. 5, line 14, i.e. the inner layer of fluid resistant material is 108 which has all its sides 117, 118 and panels 132 attached to the anchor layer, directly by stitching 127 and 129 and indirectly by welds 123, 125 and stitching 133, the sides being displaced inwardly, see Figure 7, from sides of the anchor layer and extending outwardly therefrom on the inner side of the garment to form a pocket, see Figures 7-8. With regard to claims 2-3 and 17-18, see portions cited above, i.e base is 109, stitching is 127, 129 and stitching 133 interconnects sides.

***Claim Rejections - 35 USC §103 or 102/103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brownlee.

This claim recites a product by process, i.e defines the invention by how made, i.e. corners removed instead of , e.g., cutting the original material not to include corners in the first place. As set forth in MPEP 2113 the patentability of such claims are based on the product itself

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not the method of production. If the end product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. As best understood due to the breadth of the claimed process, i.e. doesn't set forth the size or orientation of the triangular portions or how the sides are joined, e.g. overlapping, abutting etc., the end product by the claimed process is the same as or obvious from the Brownlee device.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brownlee '422 in view of Coates '526 and Ohara GB '573.

Applicant now claims an exposed edge of the pocket circumscribed by an elastic strip. Since Applicant has not provided a specific definition for the term "circumscribed" such will be given its broadest customary, i.e dictionary, definition in light of the specification. The American Heritage Dictionary defines "circumscribe" as "To draw a line around, encircle." "To confine within bounds; restrict." " To determine the limits of; define." Furthermore the strip of elastic 42 as seen in Figures 1-1H wrap the exposed edge from the inner surface to the outer surface of the pocket material as well as extend along the edge of the pocket along its entire perimeter. Therefore, as claimed, the definition of "circumscribed" as interpreted in light of the specification is broad enough to encompass wrapping the edge, extending along the entire perimeter of the pocket defined by the edge or both. The Brownlee device does not include such an elastic strip. The Brownlee device folds over a raw edge of the pocket and places elastic therein to provide a comfortable elastic edge. However, Coates '526, e.g. element 64 and col. 7,

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lines 40-42, and Ohara '573, element 10 and page 2, lines 36-40 also teach a comfortable elastic edge but provide such by wrapping or "circumscribing" the raw edge with an elastic strip. To make the folded over elastic containing edge of Brownlee an edge circumscribed by an elastic strip as taught by Coates and Ohara instead would be obvious, see *In re Siebentritt* (two equivalents are interchangeable for their desired function, express suggestion of desirability of substitution not needed to render such substitution obvious), i.e. in the instant case both configurations provide a finished elastic edge.

### ***Response to Arguments***

11. Applicant's remarks with regard to the formal matters in the 6-20-03 response have been noted but are either deemed moot in that such issue has not been reraised or deemed nonpersuasive for the reasons set forth supra. Applicant's remarks on pages 15-16 with regard to the prior art rejections have been considered but are deemed nonpersuasive because such are narrower than the claim language and the teachings of the art as set forth in the rejections supra. For example, the claims do not require the pocket to extend from the point that the sides extend from the remainder of the inner layer, i.e. the corners exposed. The claim just requires at a minimum, i.e. "comprising", the four sides to define a pocket which Brownlee does. There is no claim language which precludes the stitching. The ends of Brownlee although stitched still extend from the anchor layer and define a pocket with the other two sides. In any case stitching

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133 is not required by Brownlee, see col. 4, line 67, i.e. "may", and the end sides would still be attached by the stitching 127 and 129.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to the specification, claim 1 and the addition of claim 19.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. M. Reichle whose telephone number is 703-308-2617. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

K.M. Reichle  
KARIN REICHEL  
[Signature]

KMR

September 4, 2003

**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED  
COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***  
Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

**REVISED AMENDMENT PRACTICE**

**I. Begin each section of an amendment document on a separate sheet:**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

**II. Two versions of amended part(s) no longer required:**

37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

**A) Amendments to the claims:**

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the **text of each pending claim** (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), (previously presented) and (not entered). The text of all pending claims, including withdrawn claims, must be submitted each time any claim is amended. Canceled and not entered claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [feroor]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [14]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims not being currently amended, including withdrawn claims, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

**Example of listing of claims (use of the word "claim" before the claim number is optional):**

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

**B) Amendments to the specification:**

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [leroor]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

**C) Amendments to drawing figures:**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).

The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to [patentpractice@uspto.gov](mailto:patentpractice@uspto.gov) or by phone at (703) 305-1616.